

Notice of Allowability

Application No.

09/722,828

Examiner

Janis L. Dote

Applicant(s)

NINOMIYA ET AL.

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/10/03.
2. ☒ The allowed claim(s) is/are 1-20.
3. ☒ The drawings filed on 28 November 2000 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| <input type="checkbox"/> Notice of References Cited (PTO-892) | <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | <input type="checkbox"/> Examiner's Amendment/Comment |
| <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | <input type="checkbox"/> Other |

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1. The examiner acknowledges the amendments to claims 13-20 filed in the amendment on Oct. 10, 2003 (AMDT101003).

Claims 1-20 are pending.

The amendment to the claims filed in the amendment on Aug. 12, 2003 (AMDT081203), was not in compliance with 37 CFR 1.121, for the reasons discussed in the notice of non-compliant amendment mailed on Oct. 7, 2003. Accordingly, the amendment to the claims in AMDT081203 has not been entered.

2. Claims 7-11 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 14 and 20, which are directed to the process of using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, have been rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the office action mailed on Feb. 19, 2002, has been hereby withdrawn.

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3. The following is an examiner's statement of reasons for allowance:

The objection to the specification set forth in the office action mailed on May 13, 2003, (CTNF051303), paragraph 5, has been withdrawn in response to the amendments to claims 18 and 19, because the Asker C hardness value is not a critical element. In other words, the instant claims do not require that the recited rollers and elastic layer have a particular Asker C hardness.

The rejections of claims 15, 18, and 19 under 35 U.S.C. 112, second paragraph, set forth in CTNF051303, paragraph 7, has been withdrawn in response to the amendments to claims 15, 18, and 19.

The rejection of claims 18 and 19 under 35 U.S.C. 112, first paragraph, set forth in CTNF051303, paragraph 9, has been withdrawn in response to the amendments to claims 18 and 19.

The rejections of claims 13 and 15-19 under 35 U.S.C. 112, first paragraph, set forth in CTNF051303, paragraph 10, have been withdrawn in response to the amendment to claim 13.

The rejection of claims 7-10 under 35 U.S.C. 103(a) over US 5,250,382 (Shimojo) combined with US 5,079,123 (Nanya), set forth in CTNF051303, paragraph 12, has been withdrawn in

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response to the showings in the Rule 132 declaration, executed by Masanobu Ninomiya on Aug. 12, 2003, filed on Aug. 12, 2003 (AF/D081203). The declaration shows that Shimojo's toner in Shimojo's example 31 exhibits a value of the differential molecular weight distribution of the molecular weight 5×10^3 of 0.619%, which is outside the range of "not larger than 0.55%" recited in instant claim 7.

Claims 1-6, 12, 13, 15-19 are allowable over the prior art of record for the reasons set forth in the office action mailed on Nov. 6, 2002 (CTFR110602), paragraph 2, which are incorporated herein by reference.

Claims 7-11, 14 and 20 are allowable over the prior art of record for the reasons discussed supra.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be

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reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Palestine Jenkins, whose telephone number is (571) 272-1021.

JLD
12/19/03

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1756
1700